

Appl. No. 10/798,459

Amdt. dated January 8, 2007

Reply to office action of September 7, 2006

REMARKS

I. Introduction

As a preliminary matter, Applicants appreciate the time and courtesy extended by Examiner Phuong Thao Cao and Supervisor Examiner Charles Rones during the October 20, 2006 and December 15, 2006 telephone interviews with Applicants' representative, Grace Law O'Brien. In the interview Summary Office Paper 20061027, the Examiner stated that "In conclusion, Attorney agreed with the Examiners that the prior art still read on the claimed invention." Applicants believe that based upon the Examiner's statement, there has been a misunderstanding of the agreements made between the Examiner and the Applicants' Attorney. As such, Applicants wish to clarify that Applicants' representative, Grace Law O'Brien, did not agree that the prior art anticipated the claimed invention. Rather, Applicants and Applicants' representative submitted proposed claim amendments to Claims distinguish the applied prior art, and thus expedite the prosecution of the present application, and not because the prior art necessarily anticipated the claimed invention. Applicants regret this confusion and misunderstanding from the interview. Nonetheless, Applicants truly appreciate the Examiners' suggestion to clarify the function of the recited tool set. Accordingly, Applicants, in response, submit "Amendment A" in light of the Examiner's suggestion.

In the non-final Office Action, Applicants' Claim 6 is objected to for minor informalities. Claims 1, 7-9, and 11-15 are rejected under 35 U.S.C. §102(b) as being anticipated by Paulauskas et al. (U.S. Patent No. 6,401,033) ("Paulauskas"). Claims 2-6 and 10 are rejected under 35 U.S.C. §103(a) as obvious over Paulauskas in view of Koller et al. ("Virtual GIS: A Real-Time 3D Geographic Information System," IEEE 1995) ("Koller"). Applicants respectfully amend the claims and request the allowance of the present application.

II. Claim Objection of Claim 6

Claim 6 is rejected for minor informalities of having a duplicate of "fences." Applicants appreciate the Examiner's citation of these minor informalities. As suggested by the Examiner, Applicants amend Claim 6 by deleting the duplicate of the word

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"fences." Accordingly, Applicants respectfully request that the objection of Claim 6 be withdrawn.

III. 35 U.S.C. §102 Rejection of Claims 1, 7-9, and 11-15

A. Independent Claim 1

Paulauskas does not teach, disclose, or suggest the features of "providing a second set of data from the source database and a geographic data tool set to a computer game developer, . . . wherein the tool set is used to access the second set of data based, at least in part, upon a location criteria for developing computer games that represent at least some of the geographic features in the region as part of play scenarios of the computer games," as recited in amended Claim 1.

Claims 1, 7-9, and 11-15 are rejected under 35 U.S.C §102(a) as being anticipated by Paulauskas.¹ Applicants respectfully traverse because Paulauskas does not teach, disclose, or suggest the features of ***"providing a second set of data from the source database and a geographic data tool set to a computer game developer, . . . wherein the tool set is used to access the second set of data based, at least in part, upon a location criteria for developing computer games that represent at least some of the geographic features in the region as part of play scenarios of the computer games," as recited in amended independent Claim 1 (with emphasis added).*** To anticipate these features of independent Claim 1, the Examiner cited column 4, lines 57-65, column 6, lines 1-25, and column 7, lines 1-5 and 20-30 of Paulauskas. Specifically, from these cited portions of Paulauskas, the Examiner argues that

(see [column 4, lines 57-65], [column 6, lines 1-25], and [column 7, lines 1-5 and 20-30] wherein geographic data provided to the game programming or the geographic database 72 can be considered as Applicant's "second set of data" and the disclosure of the game applications using the geographic data [column 4, lines 57-60] implies the inclusion of a geographic data tool set as illustrated in Applicant's claim language)

See Office Paper 20060831, page 4.

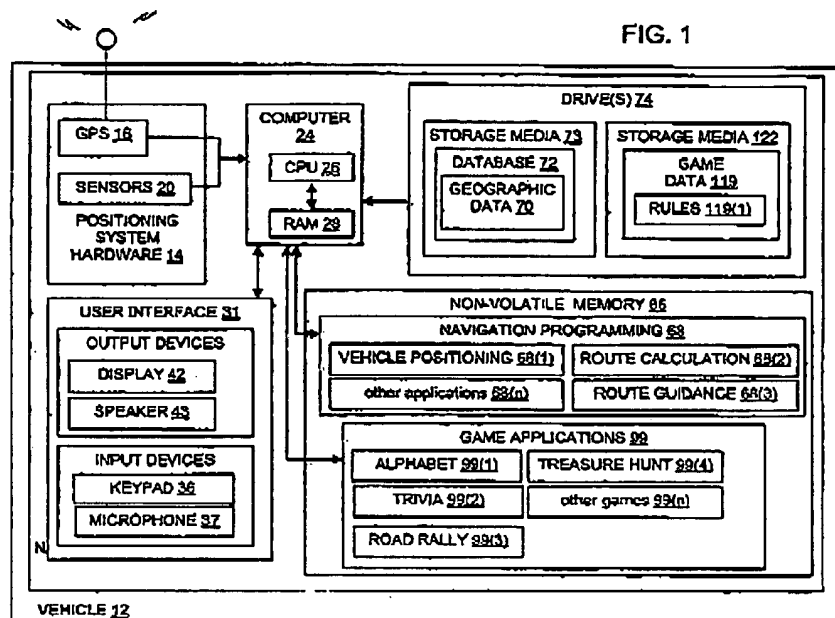
¹ Applicants first note that it is improper to make an §102 rejection based upon a combination of references. From the Office Action, It appears that the rejection is based upon an Official Notice combined with Paulauskas. If this is, in fact, the case, the rejection should be based upon a §103 obviousness rejection, instead of a §102 rejection. Moreover, should the rejection be maintained in the next Office Action based upon an Official Notice, Applicants respectfully request that an affidavit be placed into the record under 37 CFR §1.104(c)(2) to detail these facts so that Applicants can be afforded the opportunity to contradict or explain, by affidavit or otherwise, such facts. See MPEP §2144.03.

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Applicants believe that FIG. 1 of Paulauskas (reproduced below) best illustrates the descriptions of the Examiner's argument.



The Examiner's argument is based substantially upon the geographic data 70 and the game applications 99 shown in FIG. 1 of Paulauskas. Admittedly, data from geographic data 70 to the game applications 99 may be interpreted as a second set of data. FIG. 1 of Paulauskas, however, shows the geographic data 70 and the game applications 99 being processed within a single apparatus, specifically a navigation system 10 within vehicle 12. In order to clarify this distinction, Applicants amend Claim 1 to specifically recite that "providing a second set of data from the source database and a geographic data tool set to a **computer game developer**." And to further expedite the prosecution of the present application, Applicants amend Claim 1 to more clearly recite the features of the tool set, as suggested by the Examiner. In particular, Applicants amend Claim 1 to specify that "the tool set is used to access the second set of data **based, at least in part, upon a location criteria** for developing computer games."

Since the Examiner's assertions argue that the tool set is "implied," See *Office Paper 20060831*, page 4 ("second set of data" and the disclosure of the game

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applications using the geographic data [column 4, lines 57-60] implies the inclusion of a geographic data tool set as illustrated in Applicant's claim language"), Applicants believe that the Examiner is making an inherency argument by asserting that these features are implied from the cited reference, instead of being specifically disclosed. If these assertions are based on an inherency argument, Applicants respectfully request that the Examiner clarify as such. Furthermore, Applicants respectfully request that the Examiner specifically cite and explain how the cited references disclose and/or suggest the features of (1) the recited tool set and (2) the second set of data and the tool set as being provided to a computer game developer, as recited in amended Claim 1.

Moreover, if the present rejection is based upon any facts within the personal knowledge of the Examiner, Applicants respectfully request that the facts be set forth in the form of an affidavit. See MPEP §2144.03(C) and 37 CFR § 1.104(d)(2). Since Applicants believe that these recited features are not inherent from the cited reference as asserted by the Examiner, Applicants respectfully submit that independent Claim 1 may be passed to allowance.

B. Dependent Claims 7-9 and 11-15

Dependent Claims 7-9 and 11-15 ultimately depend directly or indirectly upon independent Claim 1, which has been shown as allowable above. Moreover, they introduce additional content that, particularly when considered in context with the claims from which they depend upon, comprises additional incremental patentable subject matter. Applicants reserve the right to present further arguments in the future with regard to these dependent claims. For all these reasons, Applicants also respectfully request that dependent Claims 7-9 and 11-15 may be passed to allowance.

IV. 35 U.S.C. §103 Rejection of Claims 2-6 and 10

Dependent Claims 2-6 and 10 ultimately depend directly or indirectly upon independent Claim 1, which has been shown as allowable above. Moreover, they introduce additional content that, particularly when considered in context with the claims from which they depend upon, comprises additional incremental patentable subject matter. Applicants reserve the right to present further arguments in the future with

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regard to these dependent claims. For all these reasons, Applicants also respectfully request that dependent Claims 2-6 and 10 may be passed to allowance.

V. New Claims 16 Through 21

Applicants added Claims 16 through 21 for further consideration from the Examiner. Applicants submit that these new Claims 16 through 21 are supported by the specification and no new matter has been added.

VI. Conclusion

There being no other objections to or rejections of the Claims, Applicants respectfully submit that Claims 1 through 21 may be passed to allowance.

Respectfully submitted,



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